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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1936.

No. 765.

THE MANTLE LAMP COMPANY OF AMERICA,
Petitioner,

vs.

ALUMINUM PRODUCTS COMPANY.
Respondent.

RESPONDENT'S BRIEF.

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INDEX.

Opinions of the courts below 2
Opinions in related cases involving Blair patent in suit 2
Grounds of jurisdiction 3
Statement of the facts 4
Petitioner's statement of the facts 6
Summary of argument 7
ARGUMENT 11
I. The bond and inner container of the Blair patent were never used by petitioner in its jug 11
II. The Blair patent is invalid for want of novelty and lack of invention 13
III. Decision of the Circuit Court of Appeals of the Sixth Circuit 15
IV. The Heath, Clisbee and Fox patents show lack of invention in Blair 16
The arts of shock and heat insulation are identical 18
The bond 19
V. Claims in suit of the type of claim 1 are invalid for want of invention over the Steel patent No. 1,067,072 23
VI. The claims of the Blair patent typified by claim 9 are invalid in view of Le Sieur patent No. 1,119,968 24
VII. Testimony of witnesses Brainard and Terry in this suit fails to justify Sixth Circuit Court of Appeals finding of validity 25
The testimony of Terry and Brainard is immaterial to any issue in this case 26
Testimony of Pearl A. Brainard 28
The rebuttal testimony of Amerine, Asbell and Wright 29

VIII. The Court of Appeals for the Seventh Circuit rightly labeled Blair's contribution as the result of mechanical skill only; it lacks novelty and invention 31

IX. The Blair patent is invalid for lack of sufficient disclosure 32

X. Commercial success of petitioner's jug was achieved by extensive and skillful advertising and not due to any invention by Blair 33

XI. Respondent's jug does not infringe the Blair patent 36

XII. Respondent alleged prior invention in several patents, among which are the patents to Davis & Sunderlin No. 1,333,795 and the patent to Simonson & Blair No. 1,497,764 38

Petitioner failed to establish earlier date of invention for Blair 39

XIII. Disclaimers 40

Specific disclaimers to some of the claims of the patent do not affect claims remaining in the patent 43

Conclusion 46

Appendix A—The Mantle Lamp Company of America v. Aluminum Products Company, 86 Fed. (2d) 509 i

Appendix B—Macomb Manufacturing Co. v. The Mantle Lamp Company of America, 22 Fed. (2d) 93 iii

Appendix C—Monarch Company, Inc., and Therm-A-Jug Company, Inc. v. Mantle Lamp Company of America, 22 Fed. (2d) 95 ix

Appendix D—Mantle Lamp Company of America v. Geo. H. Bowman Company (not reported) xi

Appendix E—Mantle Lamp Company of America v. Geo. H. Bowman Company, 53 Fed. (2d) 441 xv

Appendix F—Disclaimer Statutes xxv

List of Authorities.

Advance Automobile Accessories Corp. *et al. v.* Reflex Auto Accessory Co. *et al.*, 284 F. 117, 119 36
Altoona Publix Theatres *v.* American Tri-Ergon Corp., 294 U. S. 477, 487; 55 S. Ct. 455, 459 16, 4
Atlantic Works *v.* Brady, 107 U. S. 192 23
Diamond Rubber Co. *v.* Consolidated Rubber Co., 220 U. S. 428, 440 32
Eskimo Pie Corp. *v.* Levous *et al.*, 35 F. (2d) 120, 122 36
Gibson *v.* Eastern Rim & Wheel Co., 32 F. (2d) 774, 776 40
Graham *v.* Earl, 92 F. 155, 158, 159 44
Hollister *v.* Benedict & Burnham Mfg. Co., 113 U. S. 59; 5 S. Ct. 717, 723-724 30
Judicial Code, Sec. 240 (a), 28 U. S. C. A. 347 3
Knapp-Monarch Co. Substituted Plaintiff *v.* Mantle Lamp Co. of America, 81 F. (2d) 428 3
Layne & Bowler Corporation *v.* Western Well Works, Inc., *et al.*, 261 U. S. 387; 43 S. Ct. 422 4
Macomb and Monarch Cases, 22 F. (2d) 93, 95 2, 4, 16
Mantle Lamp Co. of America *v.* Aluminum Products Co., 86 F. (2d) 509 2
Mantle Lamp Co. of America *v.* Geo. H. Bowman, 33 F. (2d) 441 3, 15
McClain *v.* Ortmayer *et al.*, 141 U. S. 419; 12 S. Ct. 76, 79 35
Permutit Co. *v.* Graver Corp., 284 U. S. 52, 57-60 32, 37
Revised Statutes, Sec. 4888; 35 U. S. C. A. 33 32
Robinson on Patents, Sec. 650, Vol. II, p. 289 44
Triplett *v.* Lowell, 297 U. S. 638, 646; 56 S. Ct. 645, 649 2, 3, 10, 40, 41, 42
United States Metallic Packing Co. *v.* Hewitt Co., 236 F. 739, 742 43
Wisconsin Electric Co. *v.* The Dumore Co., 282 U. S. 214; 51 S. Ct. 214 4

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RESPONDENT'S BRIEF.

This case is before this Court for review under a writ of certiorari granted March 29, 1937, directed to the Circuit Court of Appeals for the Seventh Circuit, and based on alleged conflict of decision between that Court and the Circuit Court of Appeals for the Sixth Circuit.

The issues involve the validity and infringement of Letters Patent No. 1,435,199, granted November 14, 1922, to petitioner herein on the application of L. V. D. Blair for Heat Insulated Receptacle.

Opinions of the Courts Below.

The opinion of the District Court, embodied in the Findings of Fact and Conclusions of Law filed by Judge John P. Barnes on March 13, 1934, is not reported but appears in the record on pages 321 to 325.

The opinion of the Circuit Court of Appeals is reported in 86 Fed. (2d) 509, was filed November 28, 1936, and appears in the record on pages 493 and 494.

The opinion of this Court on questions certified to it by the Circuit Court of Appeals appears in 297 U. S. 638, 646; 56 S. Ct. 645, 649. The order dismissing the certificate is found on page 488 of the record.

Opinions in Related Cases Involving Blair Patent in Suit.

For convenient reference and access copies of the opinions in certain other cases involving the Blair patent, including the opinion of the Circuit Court of Appeals for the Seventh Circuit in the present case as reported in 86 Fed. (2d) 509 (Rec. 493), are bound at the end of this brief. They are as follows:

The Mantle Lamp Company of America v. *Aluminum Products Company,* 86 Fed. (2d) 509. Appendix A. Page i.

Macomb Manufacturing Co. v. *The Mantle Lamp Company of America,* 22 Fed. (2d) 93 (C. C. A. 7). Opinion rendered May 28, 1927. Petition for rehearing denied December 5, 1927. Appendix B. Page iii. (Patent held invalid for lack of invention.)

Monarch Company, Inc., and Therm-A-Jug Company, Inc. v. *Mantle Lamp Company of America,* 22 Fed. (2d) 95 (C. C. A. 7). Opinion rendered May 28,

1927. Petition for rehearing denied December 5, 1927. Appendix C. Page ix. (Follows ruling in Macomb case.)

Mantle Lamp Company of America v. *Geo. H. Bowman Company.* District Court of the United States, for the Northern District of Ohio, Eastern Division. Opinion of Judge West (not reported) rendered September 12, 1929. Appendix D. Page xi. (Patent held invalid for lack of invention.)

Mantle Lamp Company of America v. *Geo. H. Bowman Company,* 53 Fed. (2d) 441 (C. C. A. 6). Opinion rendered November 3, 1931. Appendix E. Page xv. (Patent held valid as to claim 1, and without prejudice to any rights of the plaintiff under any other claim; also held infringed.)

Knapp-Monarch Co. Substituted Plaintiff v. *Mantle Lamp Company of America,* 81 Fed. (2d) 428 (C. C. A. 7). Opinion rendered January 18, 1936. (Injunction against prosecution of a co-pending case in the District Court of the United States, Western District of Missouri, dissolved.)

Triplett v. *Lowell and Mantle Lamp Company of America* v. *Aluminum Products Company,* 297 U. S. 638. (Relate to questions certified in this case by Circuit Court of Appeals for the Seventh Circuit to this Court respecting necessity for filing disclaimer by petitioner.)

Grounds of Jurisdiction.

Petitioner invokes the jurisdiction of this Court under Section 240 (a) of the Judicial Code (28 U. S. C. A. 347, as amended).

As to the alleged conflict of decision between the Circuit Courts of Appeal for the Sixth and Seventh Circuits, these Circuits differ with respect to the va-

lidity and infringement of claim 1 only of the Blair patent.

The reason for this alleged conflict is one of fact. The testimony in the two Circuits was different. Because of this it is believed that the ruling in the cases of *Wisconsin Electric Company* v. *The Dumore Company*, 282 U. S. 813; 51 S. Ct. 214, and *Layne & Bowler Corporation* v. *Western Well Works, Inc., et al.*, 261 U. S. 387; 43 S. Ct. 422, is controlling and that the writ of certiorari should be dismissed as improvidently granted.

Upon the fact testimony of the witnesses Terry and Brainard which was before it, the Sixth Circuit found validity in claim 1 of the Blair patent. The Seventh Circuit found that the fact testimony of these two witnesses, as before it, was insufficient for that purpose.

Furthermore, we have the fact that respondent's accused structure in the present suit omits one of the functional elements, *i. e.*, insulating function of the bond, which the Sixth Circuit found must necessarily be read into claim 1 to give it validity.

Statement of the Facts.

The original litigation involving the Blair patent in suit terminated in the holdings that claims 1, 4, 5, 6, 7, 10, 11, 12, 13, 14, 17, 18, 21, 22, 23 and 24, were invalid (Rec. 9). These holdings were by the Circuit Court of Appeals of the Seventh Circuit in the *Macomb and Monarch cases*, 22 F. (2d) 93, 95.

Thereafter petitioner brought suit against the Geo. H. Bowman Company in the Sixth Circuit relying upon the same claims plus claim 8. The District Court found the claims again invalid and on appeal the Circuit

Court of Appeals for the Sixth Circuit limited its decision to claim 1 only (Rec. 220-227) saying:

> "We have considered only claim 1. There are other claims which are broader in some respects and do not incorporate the supporting bond. They thus present questions of validity which we have not discussed. Some other claims are narrow and suggest questions of infringement. We see no object, upon this record, in considering any of these claims.
>
> "The decree will be reversed and the case remanded, with instructions to enter the usual decree for plaintiff on claim 1, and without prejudice to any rights of the plaintiff under any other claim."

The decree under mandate in the Bowman suit held the Blair patent to be "good and valid in law as to claim one (1) and without prejudice to any rights of the plaintiff under any other claim."

The effect of this decision in the Sixth Circuit was to establish a controversy between Circuit Courts of Appeal only as to claim 1 as no other claims were passed upon by the Circuit Court of Appeals. Accordingly, under petitioner's theory of jurisdiction because of direct conflict between Circuit Courts of Appeal, only claim 1 of the Blair patent is before this Court on the writ of certiorari herein granted.

The status of the other claims remains the same as decreed in the Macomb and Monarch suits and again in the present suit—they are still under the bar of invalidty.

Petitioner's Statement of the Facts.

The Statement of Facts submitted by petitioner is replete with argument presented as fact. It has set up the structure of the Blair patent as a standard of perfection where other heat-insulated receptacles in the prior art retained heat from two to three times longer than even petitioner's commercial structure (see Clisbee, Rec. 363, line 13; and the vacuum bottle art). Blair retains heat for eight hours (Rec. 74), Clisbee for twenty-four hours, and vacuum bottles for intermediate periods. The retention of heat or cold by a container is a relative matter depending upon many variables. Blair's structure, for instance, would be a relatively poor insulator compared to Clisbee.

Means for joining metal to glass were well known in the prior art (Heath, Rec. 356; Steel, Rec. 390; Vacuum art Rec. 370, 374, 378, 382). Petitioner is wrong as to its opposite statement.

There is no statement in the record that respondent uses an adherent bond. One of petitioner's experts said that sulphur will adhere if poured in a hot molten state (Rec. 189). He did not, and could not, state that it would suspend a heavy crock by adhesion alone. Sulphur is brittle—easily cracks out if forces are exerted upon it (Rec. 103). It has no elasticity such as is ascribed to the Blair bond.

The accused device has a metal to crock or inner container contact (Rec. 103) so that the sulphur element of respondent serves no function as a non-conductor of heat between the inner container and outer jacket.

Summary of Argument.

I. The bond and inner container of the Blair patent were never used by petitioner in its jug.

(a) Blair shows and describes only an adherent bond. It has no mechanical or interlocking features or functions.

(b) The bond in commercial use is a mechanical adaptor to fit odd sized earthenware jugs to the metal jackets.

II. The Blair patent is invalid for want of novelty and lack of invention.

(a) The art of heat and shock insulation is very old.

(b) It consists of non-vacuum jugs, vacuum jugs and combinations of the two all generally constructed upon the same principle.

III. The decision of the Sixth Circuit was based upon *ex parte* record—there was no cross-examination nor rebuttal testimony.

(a) Claim 1 only was considered and passed upon.

(b) The Sixth Circuit considered it important to read into claim one the functions of heat insulation and sealing against moisture of the bond for validity and the latter is not mentioned in the patent.

(c) Respondent's jug has a metal to inner jug contact and does not utilize any heat insulating function of its mechanical tie.

IV. The Heath, Clisbee and Fox patents show lack of invention in Blair.

(a) The Heath shipping container is inher-

ently a good heat insulator and anticipates the structure set forth in claim 1.

(b) Clisbee proves Heath's applicability to the heat insulating art.

(c) If claim 1 is restricted to a third bond element not called for therein, it is not invention to add the Fox bond.

(d) The arts of shock and heat insulation are not only analogous, they are identical.

V. The claims in suit of the type of claim 1 are invalid over the Steel patent 1,067,077 (Rec. 390).

(a) It even has the third bond element not called for in the claim but relied on by petitioner.

VI. The claims in suit of the type of claim 9 are invalid in view of Le Sieur patent 1,119,968.

(a) It uses a vacuum as the equivalent of the heat insulating material.

VII. The testimony of witnesses Terry and Brainard in this suit fails to justify the Sixth Circuit finding of validity in claim 1.

(a) Their testimony was entirely different in the present Seventh Circuit suit.

(b) Their testimony is found to be immaterial to any issue in this case.

(c) All Terry did was to substitute a single walled inner container for the double walled inner container of his vacuum jug.

(d) He did not follow Blair but used his vacuum jug principle to make a jug that sold by the car load for several years and was not charged with infringement.

(e) Brainard could not remember very well.

(f) He copied nothing from Blair but began

with a Heath type of structure and developed a Steel type of structure in obvious ways.

(g) The rebuttal testimony of respondent's witnesses showed these changes clearly.

(h) Even the first jug was highly efficient.

(i) They took nothing from Blair, never adopted Blair and sold their jug by the thousands.

(j) The Sixth Circuit had none of this testimony before it.

VIII. The Court of Appeals for the Seventh Circuit rightly labeled Blair's contribution as the result of mechanical skill only; it lacks novelty and invention.

(a) Other prior art besides Heath, Clisbee and Fox is extremely pertinent.

IX. The Blair patent is invalid for want of sufficient disclosure.

(a) It discloses no mechanical interlock and when interpreted that broadly it lacks the disclosure prescribed by R. S. 4888.

X. Commercial success of petitioner's jug was achieved by extensive and skillful advertising and was not due to any invention by Blair.

(a) The sales follow the advertising expenditures.

XI. Respondent's jug does not infringe the Blair patent.

(a) It has the mechanical interlocking tie of the prior art not mentioned or shown in Blair.

(b) The tie does not afford the heat insulating function required of the Blair bond.

XII. The Blair patent is invalid by reason of prior invention in Simonson and Blair No. 1,497,764 (Rec. 452) and Davis and Sunderlin No. 1,333,795 (Rec. 420).

(a) The applications of these patents were filed many months earlier than Blair's.

(b) The claims of these patents are directed to subject-matter of the Blair patent.

(c) Certain claims of Simonson and Blair and the claims of type 1 of Blair could be inserted in either patent and be supported by the structure thereof.

(d) Petitioner failed to establish an earlier date of invention for Blair.

(e) The testimony was solely from memory as to events of fifteen years before.

XIII. Any question as to disclaimers so far arising in this suit was settled by the decision and discussion in *Triplett* v. *Lowell*, 297 U. S. 638.

(a) It was not mandatory upon the Seventh Circuit to pass on disclaimers when all claims in suit were again found invalid.

(b) The trial court first found invalidity of the claims in suit and then found there was unreasonable delay in filing disclaimers.

(c) Specific disclaimers to some of the claims of a patent do not affect the claims remaining in the patent.

(d) Each claim is its own entity.

ARGUMENT.

I.

The Bond and Inner Container of the Blair Patent Were Never Used by Petitioner in Its Jug.

Petitioner contends that the bond of the Blair patent has two-fold aspects, to-wit, (*a*) that it is an adherent bond, and (*b*) that it is a mechanical bond having an interlocking relation with the necks of the inner container and the jacket or casing.

Notwithstanding the extended description of the bond as appears from the Blair patent, there is not the slightest suggestion therein that the bond 14 exhibited in the Blair patent is of a mechanical nature, or possesses any interlocking relation between the necks of the inner container and the jacket.

Petitioner does not use the bond of the Blair patent in its commercial jug (Defendant's Exhibit No. 7). The bond of that jug is a mechanical bond. That is clear from the fact that in the neck of the inner container external circumferential grooves are formed, while at the inner sides of the neck of the jacket grooves are provided by the screw-threads of the neck of the jacket. Into the grooves of the neck of the container and the grooves of the screw-threads of the neck of the jacket the bonding material enters in its fused condition and hardens so as to provide a mechanical interlock between these parts.

If the bond of the tenacious character described in the Blair patent were sufficient to hold the inner container to the outer jacket in the pendent supported relation described in the patent, why has petitioner departed from this in the commercial structure of its jug, and resorted to a bond which is a purely mechan-

ical bond to preserve the sustained relation of the inner container to the outer jacket? Particularly is this inquiry pertinent when so much emphasis is laid on the bond in the Blair patent, and also when so strongly emphasized by petitioner's witnesses. There is but one deduction to be drawn from this situation. As a tenacious or adherent bond, that of the Blair patent is a failure. It is not the bond which the Blair patent represents it to be, neither is it the bond on which the patentability of the claims was determined by the Patent Office under the representation of Blair when his application was pending. (Rec. 262, File-wrapper and contents, Blair patent in suit, Defendant's Exhibit 10.) There is no evidence before the Court that this bond ever was used by petitioner or by Blair, so that the emphasis which has been laid thereon is without foundation. Petitioner's adoption of the mechanical bond included in its commercial jug repels the suggestion that the bond of the Blair patent possesses the characteristics ascribed to it.

Petitioner relies upon the bond under discussion to differentiate the Blair invention from the prior art. It has belittled practically every form of bond disclosed by the prior art patents which were discussed at the trial. But petitioner endeavors to differentiate the Blair bond from the prior art by its assertion that it possesses the dual characteristics of an adherent bond and a mechanical bond. Yet we see that it is forced to rely upon a bond which possesses only the characteristic of the mechanical interlock. It is not tenacious and has no adherent capability. This was proved by Mr. Miner, one of the witnesses called by respondent, and Defendant's Exhibit No. 7 (Rec. 148-149).

It is also significant to note that in the commercial jug of petitioner the latter does not employ the glass

inner container of the Blair patent. That has been substituted by the earthenware container as seen in Defendant's Exhibit No. 7. The fact that it has made this substitution gives force to the conclusion expressed by Mr. Sessions (Rec. 100) that the bond between the inner container and the jacket is really a mechanical adaptor, the same being employed because of the inability of the pottery manufacturer to make the earthenware container of uniform size or shape at its neck, thereby entailing the necessity for utilizing the material that is introduced between the necks of the container and the jacket to adapt the one to the other.

Petitioner has, therefore, departed from the teachings of the Blair patent in its commercial jug and cannot credit to the Blair patent the success solely attributable to the jug actually marketed by petitioner.

II.

The Blair Patent Is Invalid for Want of Novelty and Lack of Invention.

For fifty years or more the art has known receptacles that are insulated for both heat and shock (Rec. 348-368). Exactly the same construction has been used for insulating against both shock and heat or cold (Rec. 467-475).

About 1906 the vacuum or thermos bottle came on the market and merely substituted the double-wall inner vacuum container for the inner containers known theretofore (Rec. 370-384). A combination of the two is shown in such structures as the Steel patent, No. 1,067,072 (Rec. 390), Stanley patent, No. 1,071,817 (Rec. 396), Le Sieur patent, No. 1,119,968 (Rec. 402), and Sturgis patent No. 1,161,266

(Rec. 406). All of these patents are for heat insulated receptacles. They are so constructed that they are inherently good shipping containers. The opposite is also true—a frangible container properly insulated against shock and used for shipping purposes is inherently an efficiently heat-insulated receptacle as it must contain the exact or similar structure (Rec. 356, 366, 467-475).

This necessary structure always comprised an inner container of frangible material or steel surrounded by an outer protective jacket and having shock-absorbing and heat-insulating material interposed therebetween. This heat-insulating and shock-absorbing material has varied from pulverized charcoal of the Clark patent of 1865 (Rec. 349) to pulverized cork chips, shown in Heath (Rec. 356), and sawdust (Rec. 362) to the "Zonolite" now commonly employed and used by respondent in its structure.

It has been the practice of the art in these shipping containers, and in the heat-insulated receptacles, to prevent any metallic contact between the inner container and the outer jacket wherever possible to prevent a loss of heat or cold and to prevent breakage of the inner container. Consequently, a mere glance at the art (Rec. 348-475) shows clearly that these inner containers have been supported by their necks to the outer jacket in practically every instance.

The first eleven findings of fact (Rec. 321-322) summarize the position of the art when Blair put his structure together.

Lack of invention in the Blair structure is apparent from this prior art.

The petitioner's brief is rather inconsistent for it argues on page 17 that the opinion of the Circuit Court

of Appeals for the Seventh Circuit in the present suit should be read in the light of the Macomb and Monarch opinions previously rendered by it as its last decision was not based upon any new reasoning. On page 12 of its brief, however, it states that the Circuit Court of Appeals adopted the District Court's finding of invalidity of the patent for failure to file disclaimer and goes on to argue this point in the latter part of its brief. (Brief 41-44.) The Court of Appeals either adopted or did not adopt the District Court's findings since it affirmed the decree without making other findings. As the Court did not disturb them, the findings of the District Court still stand.

III.

Decision of the Circuit Court of Appeals of the Sixth Circuit.

In the first part of its opinion in *The Mantle Lamp Company of America* v. *Geo. H. Bowman Company,* 53 Fed. (2d) 441 (Rec. 220), the Circuit Court of Appeals for the Sixth Circuit pointed out clearly that, other than by the filing of an answer, there was no defense by the defendant. "The plaintiff voluntarily put in evidence all the patents set up in the answer." From the remainder of that opinion it is obvious that petitioner placed in evidence everything favorable to its position and derogatory to the prior patents set up as prior art. Apparently the testimony of two witnesses, Brainard and Terry, who suffered no cross-examination, was the turning point of the Sixth Circuit decision.

The Sixth Circuit had trouble with claim 1 of Blair, both as to validity and infringement. It admitted that it was of considerable importance to read into

claim 1 the insulating and moisture excluding functions of the Blair bond by using the implied "substantially as described." Blair's patent omits reference to the moisture-excluding values of his bond so that even this function was not properly included in the claim. The prior art does mention moisture sealing as will be pointed out hereinafter.

"The patent thus upheld is one which was neither claimed nor granted." *Altoona Publix Theatres* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 487, 55 S. Ct. 455, 459, and cases there cited.

Respondent's structure receives no insulating value from the mechanical tie used by it as the metal flange of the outer jacket rests directly upon the upper edge of the inner container (Rec. 103). Respondent's structure lacks the very limitation relied upon by the Sixth Circuit to give life to claim 1.

Consequently, it is obvious that the facts upon which the Sixth Circuit based its decision are different from the facts of the present case.

Respondent's position is that Blair must be limited to the structure shown and described which includes the tenacious, insulating lac bond for which a patent was obtained in the name of Simonson and Blair (Rec. 413). This is the only type of bond mentioned in the Blair patent (Rec. 344, lines 72-102).

IV.

The Heath, Clisbee and Fox Patents Show Lack of Invention in Blair.

The patents to Heath, Clisbee and Fox contain the same elements and they function in the same way as those elements in the Blair patent.

In the Macomb and Monarch suits (22 F. (2d) 93,

95) the Court of Appeals relied strongly upon the Heath patent (Rec. 356). The structure shown and described therein is a complete anticipation of the structure called for in claim 1 of Blair chosen by petitioner as typical of one group of claims.

Petitioner had argued that Heath was in a non-analagous art and that there must be a third element between the inner container and the outer jacket to be a seal, although claim 1 is silent as to this. For this reason the Court cited the Clisbee patent (Rec. 360), which differs from Heath in having a metal inner container, to show that obviously Clisbee and Heath were in the same field and art. To answer the insistence that a third element of a moisture excluding seal should be present, although not described in the Blair patent nor claimed, the Court cited Fox (Rec. 366) and said it would require only mechanical skill to place such a moisture proof seal in Heath. The Court could see no invention in Blair and was right. Such moisture proof seals were common in the art (Rec. 371, lines 48-50, 60-65; 379, lines 79-89; 392, lines 25-29). As the accused structure in the Macomb suit had a seal of plaster of Paris and cement the Court could be expected to apply and rely upon similar plaster of Paris seals from the prior art.

In the Heath patent there is a mechanical interlock or bond which suspends the inner container within the outer jacket at its neck.

In the Fox patent there is a plaster of Paris seal between the neck of the inner container and the outer jacket to exclude water or moisture from the packing material.

Petitioner went to great length in attempting to prove at the trial that Heath did not show a pendent

structure but that the flanged neck of the inner container would be above the outer jacket because of the heavy shading in the drawing (Rec. 178, 179). The absurdity of this position becomes apparent when, by the same token, it would appear that the stopper of Heath is not shown as supported in the neck of the inner container. The District Court was not misled by this type of testimony (Rec. 179).

Petitioner, in its brief (p. 19), argues that no one, without experimentation, would be able to determine how much heat insulation would be given by the shock absorbing substance used by Heath and Fox. The absurdity of this is obvious when we read the specification of the Blair patent (Rec. 344, lines 26-50). This is the only mention in the patent of how much or what kind of insulation is used by Blair and he talks of it only in terms of shock insulation, using any material having "poor heat-conducting properties, such as cork."

The Arts of Shock and Heat Insulation Are Identical.

In view of the structure of the Heath patent which had for its main object the prevention of breakage during transportation, the French patent No. 411,568 of Lodo and Gassend (Rec. 473-475) is of great interest because of its disclosure of the use of almost the same structure as Heath for the dual purpose of protecting against shock and variations in temperature. In the first paragraph of this French patent it states that its object is to preserve fragile receptacles from exterior shocks and to protect the merchandise transported therein against sudden variations of tempera-

ture. To attain this object a glass inner container 13 is supported by a flanged neck from an outer jacket 6 and triturated or powdered cork is packed therebetween. In the last paragraph of the specification these inventors say:

> "The triturated cork is an excellent heat insulator and, as such, retards all rapid heat exchanges between the inside and outside; it therefore acts as a shock absorber and a heat insulator."

This is further proof that ground cork has been well known in the art as having the inherent qualities of a good heat insulator and a good shock absorber. It cannot act as one without being the other.

The Bond.

Petitioner attempts to build up a case of invention in the Blair patent by giving unusual properties to the bond 14. This bond, according to petitioner's brief, may form either a mechanical interlock between the inner container and the outer jacket or an adhesive tie between the two, and, moreover, seals the space between them so that no moisture can enter therebetween. Any moisture sealing properties of this so-called "bond" are not mentioned in the specification of the Blair patent. Nowhere is the bond described as forming any mechanical interlock. Instead, it is said (Rec. 344, lines 91-95):

> "The tenacity of this bond is such that it is capable of supporting the container in its pendant position with the jacket without the aid of adjunctive supporting devices."

In the Macomb suit the accused device was almost exactly similar to the respondent's structure in the

present suit (Rec. 253) with the exception of the fact that its bond between the inner container and the outer jacket was of plaster of Paris and cement (Rec. 47, 95). Consequently, petitioner, in the Macomb case, recognized plaster of Paris bonds as coming within the Blair patent. Petitioner changed its position in the Sixth Circuit suit and again in the present suit and urges the Court to believe that a plaster of Paris bond will not function as a bond and is inefficient.

The Fox patent (Rec. 366) shows a plaster of Paris bond which ties the inner container to the outer jacket, holding the inner container firmly in place and excluding water or moisture from the packing material (Rec. 367, lines 70-75). The record contains other plaster of Paris bonds as pointed out above. Under the well settled rule that a structure which infringes if later, will anticipate if earlier than the patent in suit, petitioner must recognize these plaster of Paris bonds or be permitted such a change in position as is inequitable to the public.

A further absurdity, apparent in petitioner's brief (page 21), is where it asserts that the only reason for the use of a plaster of Paris bond in the Fox patent is for incombustibility to prevent conflagration by the spilling of acid in the container. Fox shows the outer frame or jacket as a box of wood. It would be silly to make 99/100 of a box of combustible material and have the remaining 1/100 of incombustible material to prevent conflagration. Whether the Fox bond suspends the inner container or not is of little moment in this suit as Mr. Johnson testified that "a bond is anything that ties two things together" (Rec. 80).

Petitioner argues that its bond is a third element which is additional to and intervenes the inner container and the outer jacket (Brief, 21). It is not

so claimed in claim 1 which is pointed out on page 39 of the brief as being typical of the claims. All that is called for is an inner container bonded to and pendantly supported from a jacket. The Heath patent (Rec. 356) shows this clearly since a bond is anything that ties two things together. The mechanical interlock between the flange and the neck of the inner container of Heath and the neck of the outer jacket *B* is a bond within the meaning of this claim. In fact, this Heath patent is a complete anticipation of claim 1. It does not discuss any sealing qualities of the bond to prevent moisture from entering into the packing. Neither does Blair. In order to show sealing qualities the Court in the Macomb and Monarch cases thought it would be obvious to place plaster of Paris around the top of the Heath structure as was done by Fox and the rest of the prior art (22 Fed. (2d), 93, 94, 95). The sealing quality ascribed by petitioner to the bond of Blair is one of petitioner's afterthoughts in its grasp for an inventive straw.

Of striking significance to petitioner's contentions is the Lyman patent (Rec. 378) which discloses an outer jacket, an inner container, insulating material between the jacket and container, and a bond and seal between the necks of the jacket and container. The patent states (Rec. 379, lines 79-89) that the insulating material 7 must be securely sealed between the outer shell 6 of the container and the casing or jacket 1 to prevent water or liquids leaking into the space occupied by the insulating material. For this purpose a plaster of Paris *joining* ring 11 between the neck 3 and jacket 1 is employed. The ring 11 is both a bond and a seal.

The claims of the Blair patent, typified by claim 1, are directed to a heat-insulated receptacle of the non-

vacuum type having an outer jacket of non-frangible material, an inner container of frangible material, the inner container being bonded to and pendently supported from the jacket, and heat insulating and shock absorbing means surrounding the inner container. This combination is old in the prior art. Blair did not invent the combination.

The burden of petitioner's contention before this Court, as it has been before all of the other Courts where the Blair patent has been asserted, is that the bond employed by Blair has certain characteristics as a non-conductor of heat and as a seal against the admission of moisture to the heat-insulating and shock-absorbing means that surround the container. The Simonson & Blair patent (Rec. 413), which is mentioned at page 2, lines 72-102, of the Blair patent (Rec. 344), covers this bond material. It was issued to and is owned by petitioner. Petitioner, therefore, possesses a patent for this bonding material. It has its monopoly thereof.

If petitioner is entitled to any protection for the bond with its characteristics that are ascribed thereto as a bond for heat-insulated receptacles, that protection is afforded by the Simonson & Blair patent. Blair did not invent the bond. That was the creation of Simonson & Blair. The combination of the Blair claims in suit is old and petitioner is not entitled to protection for this old combination by reading into that combination the bonding material covered by the Simonson & Blair patent.

If respondent has appropriated the bond, suit should have been based upon the Simonson & Blair patent and not upon the Blair patent in suit, which latter patent is directed to an old combination the invention of which

was exhausted by the disclosure of the prior art and which could not be modified by the bonding material covered by the Simonson & Blair patent.

The design of the patent laws is to reward those who make substantial discovery or invention which adds to the fund of knowledge and makes a step in advance in the useful arts. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea that would naturally occur to skilled mechanics in the ordinary progress of manufactures. *Atlantic Works* v. *Brady*, 107 U. S. 192. In the light of the prior art the Blair patent in suit is within the condemnation of this case.

V.

Claims in Suit of the Type of Claim 1 Are Invalid For Want of Invention Over the Steel Patent No. 1,067,072 (Rec. 390).

Both a mechanical interlocking bond and a sealing bond is disclosed in the Steel patent No. 1,067,072 (Rec. 390) where the inner frangible container 26 is suspended by a screw-threaded neck from the screw-threaded neck of the outer metallic jacket 17. In lines 25-29 of page 2 of this patent, it is mentioned that "cement or other well known means may be interposed between the threaded portions" to seal the same for forming an airtight joint. Here in Steel is a dominant characteristic of the Blair structure. *Here we have the third element or bond so relied upon by petitioner.* It was not cited previously by the Courts.

The Steel patent is a complete anticipation of the Blair claims with the addition that Steel uses a partial vacuum as an additional heat-insulating means. Claim 1, for instance, when read on Steel is as follows:

(*a*) "A heat-insulated vessel of the non-vacuum type having an outer jacket of non-frangible material," (Steel, Rec. 390, has the outer metal receptacle 17).

(*b*) "an inner container of frangible material," (Steel has the inner container 26 of glass)

(*c*). "said inner container being bonded to and pendently supported from said jacket," (Steel has container 26 bonded to and pendently supported by screw-threaded neck 28 to screw-threaded neck 23 of the outer receptacle *with cement interposed therebetween*)

(*d*) "and heat-insulating and shock-absorbing means surrounding said container for limiting oscillations of said container while permitting expansion thereof by changes of temperature." (Steel has the heat-insulating body 29 surrounding the container 26, lines 37-42, page 2. This is also a shock-absorbing means, lines 64-71, page 2. The space between containers is also made into a partial vacuum for additional heat insulation.)

VI.

The Claims of the Blair Patent Typified by Claim 9 Are Invalid in View of Le Sieur Patent No. 1,119,968.

With reference to claim 9 of Blair set forth in petitioner's brief, p. 39, as one of the typical claims, the Court's attention is respectfully directed to the drawings of Le Sieur (Rec. 402).

Reading claim 9 upon Fig. 1 of such drawings it will be seen that Le Sieur discloses:

(*a*) a heat-insulated vessel having an outer jacket (1);

(*b*) an inner single-wall container (2) provided with a neck (6);

(*c*) a heat-insulating medium (3) surrounding said container;

(*d*) a closure (11) for the neck of said container separated from the inner wall of said neck by a heat-insulating air space; and

(*e*) a heat-insulating gasket (9) disposed between said neck and said closure (11).

Le Sieur uses a vacuum instead of "a body of heat-insulating material." The latter is merely an equivalent adding nothing of inventive value to Blair.

Le Sieur (Rec. 402, lines 53 to 59) states:

> "I have carefully insulated the inner can, so that it will have no metallic connection whatever with the external can."

Claim 9 is answered so completely by Le Sieur as to require no further discussion.

VII.

Testimony of Witnesses Brainard and Terry in This Suit Fails to Justify Sixth Circuit Court of Appeals Finding of Validity.

The record in the case at bar contains the testimony of Brainard and Terry. While these same witnesses testified in the Sixth Circuit case and the testimony there probably caused the holding of validity in claim 1, their testimony in the present suit is entirely different, was subjected to cross-examination for the first time, and was rebutted.

The Circuit Court of Appeals for the Seventh Circuit gave the Brainard and Terry testimony every consideration as it appeared before it but was "not convinced that the additional testimony is sufficient to warrant us in departing from the former rulings of

this Court in the Macomb and Monarch cases." (Rec. 494.) This was a concurrence in Findings 34 and 35 of the District Court (Rec. 324).

The Testimony of Terry and Brainard Is Immaterial to Any Issue in This Case.

Terry was a vacuum bottle manufacturer and discussed the production of this type of bottle. In so far as he even mentions petitioner's jug, which does not follow the Blair patent, we find that Terry learned nothing from petitioner except what was obvious.

In 1920 Terry saw one of petitioner's jugs, took it to the factory, and tore it apart (Rec. 62). His company had supported its vacuum bottle on a metal tripod spring resting on the bottom of the outer container and had placed a heavy rubber ring around the neck of the container (Rec. 61). After they tore petitioner's jug apart, they did the obvious thing of substituting a single-walled gallon jug for their former double-walled vacuum container and supported it within the outer jacket by the tripod spring and the rubber gasket in precisely the same way in which they had supported the double-walled vacuum container (Rec. 62). It was an obvious substitution of equivalents. The gallon jug so produced by Terry's company was a heat-insulated non-vacuum jug (Rec. 62, 63).

This non-vacuum jug went on the market and Terry's company continued to manufacture the same after Terry had left (Rec. 63). This jug was made and sold by the carload for about three and a half years. Approximately 150,000 to 200,000 were made and sold. The construction was not changed at all (Rec. 64, 65). It was not a copy of Blair nor of petitioner's structure, nor a failure.

At page 35 of petitioner's brief, under Point IV, petitioner says:

> "The present record now clearly shows that those highly skilled in the art, even with the Blair device before them, failed to see that a single path of heat-conductivity, and dry insulation were necessary in combination with the other essentials disclosed by the Blair patent."

At page 36 of the brief, under Point V, petitioner also says:

> "The fact that the skilled makers of heat-insulated receptacles did not make a satisfactory heat-insulated receptacle of the non-vacuum type until they saw and appropriated Blair's invention argues strongly for the invention of Blair."

The first of the above statements is without point, and the latter statement is not only misleading but without foundation in view of what Terry and his company accomplished in the production of the non-vacuum jug which they produced and sold.

Terry's skill was manifested by the production of a jug which not only did not infringe the Blair patent, but also did not embody the Blair structure. He produced a jug that was practical and which was sold in large quantities. Terry did not find it necessary to borrow from Blair. He struck out on his own path and produced a jug which was so original that his company was never notified of infringement of the Blair patent by petitioner. They continued to make them unmolested by petitioner during the period Terry was with the company (Rec. 65), thus clearly evidencing the non-infringing character of these jugs and the fact that Blair taught Terry and his associates nothing. Terry merely substituted an earthenware, single-walled container for his double-walled,

glass vacuum bottle and got his heavy jug. Terry's skill, therefore, produced a satisfactory heat-insulated jug of the non-vacuum type without appropriating Blair's alleged invention, the declaration of petitioner to the contrary notwithstanding.

Most of Terry's testimony was with reference to their failure in the manufacture of making gallon size vacuum bottles. Obviously, there could be nothing of invention in the structure of a gallon size vacuum bottle over a quart or pint size. All the art needed was a new process for making the larger size of vacuum container to prevent the large percentage of breakage. Apparently, this new process has been discovered as petitioner's witness Johnson testified that gallon sized vacuum bottles are now on the market (Rec. 74).

Testimony of Pearl A. Brainard.

The Seventh Circuit record of Brainard (Rec. 46-49) was primarily that he could not remember. There is nothing in the record (pages 46-48) to show that the jugs manufactured by the Macomb Manufacturing Company, of which Brainard was the president in 1920, were failures, or that he copied anything from either the Blair structure or from petitioner's jug. Three of his former employees were in court during his testimony and this may have accounted for his failure to live up to the expectations of his testimony in the Sixth Circuit.

Mr. Brainard did testify that the first jug manufactured by his company was like that shown in the drawing in the record (page 239). This shows an inner container having a grooved or slotted neck. This

inner container is pendently supported from the outer jacket by having the breast of the jacket contracted into the slotted neck—a structure closely approaching the Heath patent (Rec. 356). He also discussed the later type of Macomb jug which had the plaster of Paris and cement bond (Rec. 47). It was this last type of jug that was charged to infringe the Blair patent in the early Macomb suit.

The Rebuttal Testimony of Amerine, Asbell and Wright.

These three witnesses were employes of the Macomb Manufacturing Company at the time that Brainard was president. Their testimony corroborated Mr. Brainard's in so far as the early jug was concerned. Their testimony shows the development of the Macomb jug from this early Heath type of structure to the jug charged to infringe the Blair patent in the earlier suit (22 Fed. (2d) 93), which is almost exactly similar to respondent's jug.

The first jug of Macomb was like the drawing at page 249 of the record (Rec. 87-88). The neck of the outer jacket was crimped into a groove in the neck of the inner jug, pendently suspending the latter therefrom. This is the Heath pendent support formed by the interlock at the neck. This early Macomb jug used plaster of Paris and cement on the outside of the jacket to seal the junction at this interlock. In use, this plaster of Paris was exposed and would chip off, permitting the insulating ground cork to escape (Rec. 87-88).

To remedy this, Macomb merely placed the plaster of Paris on the inner side of the outer jacket at the

neck (Rec. 88-94) as in the drawing at page 251 of the record. This was a successful jug and lacked only appearance to equal any of the present day jugs. But the customers wanted a better looking jug (Rec. 89).

The appearance was remedied by Mr. Amerine in bringing the neck of the outer jacket up over the neck of the inner container as in the drawing on page 253 of the record. The plaster of Paris and cement was used as a mechanical interlock between the grooves in the neck of the inner container and the screw threads in the neck of the outer jacket as in the Steel patent (Rec. 390) and all present-day jugs. The screw threads on the neck of the outer jacket were to support a drinking cup cover (Rec. 95). This is also shown in Heath (Rec. 356).

These slight changes were all obvious from the prior art of Heath and Steel and do not spell invention in the Blair device, which shows no such mechanical inter-lock. *Hollister v. Benedict & Burnham Manufacturing Co.*, 113 U. S. 59; 5 Sup. Ct. 717, 723-724.

The first jugs with the cement outside were as thermally efficient as the present-day jugs. They were not failures (Rec. 95).

This additional testimony of Amerine, Asbell and Wright was not before the Sixth Circuit. The cross-examination of none of petitioner's witnesses was before the Sixth Circuit.

The Sixth Circuit Court of Appeals had no testimony before it to show that Terry's company merely substituted a single inner wall container for a double-walled inner container and thereby produced a practical jug without employing the Blair structure or paying tribute to Blair. The Sixth Circuit Court of Appeals had no testimony before it to show that all

Macomb did was to change the Heath structure into the Steel structure. The Sixth Circuit was led to believe that the attempts to market these early articles of Terry's and Brainard's was abandoned. This record shows that Terry's container was sold by the carload and manufactured after he left the company. It also shows that Brainard's early jug was made for several years, even after the changed form came into existence and was made by the thousands (Rec. 88, 90, 93, 94).

When Amerine designed the jug shown by Defendant's Exhibit No. 4 (Rec. 253) he had nothing to guide him in making the design—he had no jugs of any other manufacturer, or patents, or anything that would disclose any other construction (Rec. 90).

The art and all modern jugs use the mechanical interlock and not the Blair structure.

VIII.

The Court of Appeals for the Seventh Circuit Rightly Labeled Blair's Contribution As the Result of Mechanical Skill Only; It Lacks Novelty and Invention.

The present record clearly shows that those men highly skilled in the art merely followed the prior art in making the various changes in reaching the present day jug.

Blair also has followed these same general rules and has made no invention.

Other prior art besides Heath, Clisbee and Fox is pertinent. Throughout petitioner's brief it is inferred that the only thing before this Court is the validity of the Blair patent in view of the patents to Clisbee,

Fox and Heath and the testimony of Brainard and Terry. Obviously, petitioner is attempting to have this Court review, not the record in the present case, but the findings of the Circuit Court of Appeals in the Macomb and Monarch cases in view of the testimony of Brainard and Terry as it was accepted by the Sixth Circuit. On page 36 of its brief, petitioner states that no single patent of the prior art provided the invention of the Blair jug and cites respondent's expert's testimony in the record at page 144. The Blair patent has twenty-four claims which might be divided into three groups. Petitioner has assisted in this division by setting forth claim 1 and claim 9 as representing two of these groups. The third group may be considered as those claims not in suit. There are individual patents that disclose everything in each of these three groups as pointed out hereinbefore (pp. 17, 23, 24, *supra*).

In an effort to becloud these issues which were strongly presented to the District Court and the Circuit Court of Appeals in the Seventh Circuit, petitioner hides its discussion of these additional patents and the pertinent vacuum bottle art in an appendix.

IX.

The Blair Patent Is Invalid for Lack of Sufficient Disclosure.

Petitioner has cited the case of *Diamond Rubber Co.* v. *Consolidated Rubber Co.*, 220 U. S. 428, 440, with respect to the familiar phrase that defendant gives its praise to the prior art while it gives the Blair jug the tribute of its imitation. Respondent would respectfully remind the Court that petitioner has

paid no tribute to the Blair patent. It uses the mechanical interlock of the Steel patent as does respondent and not the tenacious adherent bond shown and described in the Blair patent (Miner, Rec. 148, 149). Such a mechanical interlock is neither shown nor described in the Blair patent. Under the law of the case of *Permutit Co.* v. *Graver Corporation,* 284 U. S. 52, 57-60, if the Blair claims are construed to read upon a mechanical interlock, the patent is invalid for lack of the disclosure prescribed by *Revised Statutes,* Sec. 4888; 35 U. S. C. A. 33.

In reaching the conclusions in The Permutit case Mr. Justice Brandeis (pp. 57, 58) made the following observations:

> "There is no mention in the specification of either a 'free' or a 'locked' zeolite bed; or of the alleged discovery that a rising space above the zeolite bed is necessary for the successful operation of the softener; or of the need of a device to prevent the lighter grains of zeolite from passing out in backwashing. . . . As the patentee has thus failed to give in the specification 'a written description' and has likewise failed particularly to point out and distinctly claim the free zeolite bed, as 'the part, improvement, or combination which he claims as his invention or discovery,' the patent is void."

X.

Commercial Success of Petitioner's Jug Was Achieved By Extensive and Skillful Advertising and Not Due to Any Invention by Blair.

Beginning in 1919 with its advertising schemes, petitioner was fortunate enough to have its Aladdin Thermalware dishes and containers used by a com-

munity kitchen in Evanston, Illinois, which was operated by a group of socially prominent women. These women traveled over the country advertising Aladdin Thermalware dishes and containers. They appeared before women's clubs and at the Chautauqua assembly at Chautauqua, New York (Rec. 76).

This scheme was a forerunner of the overworked type of advertising of the present day, which uses the names and pictures of prominent individuals and celebrities who, for proper consideration, endorse most anything.

Beginning with this endorsement by these women petitioner entered upon a vigorous advertising campaign, utilizing magazines, broadsides and radio broadcasts. Their sales began to mount rapidly. Mr. Presba testified as to the amounts of advertising for Aladdin jugs in each year (Rec. 69). As is obvious from these figures, the sales of the jugs increased as the amount expended in advertising increased, and the sales decreased with the decrease in advertising These expenditures were as follows:

1920	$11,000.00
1921	12,000.00
1922	18,000.00
1923	40,500.00
1924	78,800.00
1925	52,000.00
1926	44,000.00
1927	36,000.00
1928	2,200.00
1929	5,400.00
1930	1,900.00
1931	300.00
1932	4,300.00

The peak of the advertising was reached in 1924.

At that time approximately 1,000,000 jugs had been sold (Rec. 77).

In the fall of 1927 the Blair patent was held invalid as to certain claims in the Monarch and Macomb suits.

The history of the alleged commercial success is easily read from this record. As the advertising increased, the sales increased—both reaching a peak in 1924. After the judgments of the Court of Appeals for the Seventh Circuit were rendered in the fall of 1927, the advertising dropped and the sales decreased. In the last three or four years, with advertising at its lowest ebb as noted above, the business of petitioner in jugs was very small. Some jugs are being sold today but not in any great quantity (Rec. 77). Surely, advertising more than played its part in the sales of petitioner's jugs. Yet petitioner would have us attribute commercial success in its device to invention on the part of Blair.

This evidence brings this case squarely within the rule of law laid down in *McClain* v. *Ortmayer et al.*, 141 U. S. 419; 12 Sup. Ct. 76, 79, where the Court said:

> "That the extent to which a patented device has gone into use is an unsafe criterion, even of its actual utility, is evident from the fact that the general introduction of manufactured articles is as often effected by extensive and judicious advertising, activity in putting the goods upon the market, and large commissions to dealers, as by the intrinsic merit of the articles themselves. The popularity of a proprietary medicine, for instance, would be an unsafe criterion of its real value, since it is a notorious fact that the extent to which such preparations are sold is very largely dependent upon the liberality with which they are advertised, and the attractive manner in which they are put up and exposed to the eye of the purchaser."

See also *Advance Automobile Accessories Corporation et al.* v. *Reflex Auto Accessory Co. et al.*, 284 Fed. 117, 119 (C. C. A. 7), and *Eskimo Pie Corporation* v. *Levous et al.*, 35 F. (2d) 120, 122 (C. C. A. 3).

Advertising and clever sales showmanship accounted for the commercial success of petitioner's jug.

There is no evidence of any licenses having been granted under the Blair patent or any recognition of the same to indicate public acquiescence in its validity.

XI.

Respondent's Jug Does Not Infringe the Blair Patent.

Respondent's jug comprises an inner container made of earthenware and having a neck with two well-defined grooves running circumferentially thereabout. It has an outer jacket spaced from the inner container throughout the body portion, which is turned inwardly adjacent the neck of the inner container and flanged to project over the mouth of the inner container. The neck of the outer jacket has screw threads thereon to receive a cap.

These screw threads of the outer jacket and the grooved portions on the neck of the inner container are opposite one another. The necks of the inner container and the outer jacket are connected together by means of a mechanical interlocking tie which is held in place between the grooved and threaded portions of these two members. With earthenware containers it is difficult to make the necks of a uniform diameter so that they can be threaded to fit into metal screw threads. Instead, respondent employs a mechanical interlock made by pouring sulphur in a plastic state between the necks of the outer jacket and the inner

container while the breast or top of the jacket and the container are inverted (Rec. 86), permitting the sulphur to harden and thereby forming the interlock between these two portions. This interlock of respondent's structure is of such a rigid nature that the jug cannot oscillate nor have pendulous movement with respect to the outer jacket. The whole breast of the outer jacket must be deformed if the inner container is to be moved with respect thereto.

The Blair patent mentions no such mechanical interlock, but instead speaks only of a tenacious bond of a type which will adhere to and support the smooth glass wall shown in the Blair patent. To be valid, in view of *Permutit* v. *Graver Corporation,* 284 U. S. 52, the claims of the Blair patent must be limited to this tenacious bond. To construe it otherwise would not only make the claims read upon Steel and Heath, for example, but would be to construe the claims in a manner not justified by the Blair description and showing.

Even assuming the construction of the Blair patent as interpreted by the Sixth Circuit by adding the limitation that the bond insulates the inner container from the outer jacket respondent's structure is not within the claims. There is direct contact between jacket and container (Rec. 103).

XII.

Respondent Alleged Prior Invention in Several Patents, Among Which Are the Patents to Davis & Sunderlin No. 1,333,795 (Rec. 420) and the Patent to Simonson & Blair No. 1,497,764 (Rec. 452).

The Davis & Sunderlin application was filed nearly a year before the application of the patent in suit, while the Simonson & Blair application was filed nearly a year and a half before the Blair application was filed.

These two patents are also owned by petitioner herein and together with the one in suit are for practically identical inventions. They establish in petitioner a monopoly of 169 claims.

An inspection of the drawings, specification and the 119 claims of the Simonson & Blair patent show that these claims are directed to subject-matter identical with that of the Blair patent in suit.

Reading claim 1 of Blair upon this patent, we find that it discloses an outer jacket, an inner container of frangible material, said inner container being bonded to and pendulously supported from said jacket, and heat-insulating (vacuum) and shock absorbing means (braces "E" of elastic organic bonding material) surrounding said container for limiting oscillations of said container while permitting expansion thereof by changes of temperature.

Simonson and Blair show both an adherent (Figs. 9 and 12) and a mechanical or interlocking bond (Figs. 1, 5 and 6). The shock absorbing means or braces "E" tend to prevent a pendulous movement of the container within the jacket (Rec. 456, lines 63 to 69). The outer jacket serves as a protective covering and may be of

metal (Rec. 453, lines 102 to line 3, Rec. 454). Simonson and Blair, in claims 90, 91, 93, 98, 99, 101, 103, 107 to 112 inclusive, and 118, claim the subject-matter of the Blair patent. These claims and the claims of type 1 of the Blair patent could be inserted in either patent and be supported by the structure thereof.

Petitioner Failed to Establish Earlier Date of Invention for Blair.

In order to carry back the Blair date of invention prior to the filing date of that of the Simonson & Blair patent, petitioner called Mr. Simonson who testified solely from memory. According to Mr. Simonson (Rec. 207), Mr. Blair was carrying on experimental work on his jug in the spring of 1918. The application of the Simonson & Blair patent was *filed* in the spring of 1918.

Mr. Johnson testified solely from memory that Mr. Blair had made heat-insulating receptacles like that shown in the Blair patent in January of 1918. In an attempt to corroborate this memory evidence, a contract dated December 22, 1917 (Rec. 246), was brought forward which mentions "vacuum bottles, vacuum containers, seals, sealing compositions, and sealing devices, and also improvements and inventions known as 'Ke-lo vacuum bottle' ". In the latter part of this contract it is stated:

> "Under the foregoing conditions, the Mantle Lamp Company of America agrees to proceed with the development, patenting, manufacture and marketing of the vacuum bottles and containers above referred to. . . ."

The subject-matter of this contract was wholly

vacuum bottles and *vacuum* containers as distinguished from any *non-vacuum* containers. As this contract showed everything that petitioner took from Blair and his co-workers, it is obvious that the structure of the patent in suit was not in existence at the date of this contract.

Petitioner's witnesses testified solely from memory as to events which took place fifteen or more years before they testified. Testimony of this nature when not related in some way with letters, drawings, physical exhibits, or documentary evidence of some kind, is entitled to little weight under the authorities.

Gibson v. *Eastern Rim & Wheel Co.*, 32 F. (2d) 774, 776 (C. C. A. 3).

It is not too much to say that the memory statements of these witnesses are, beyond doubt, as favorable to petitioner as the facts will allow.

XIII.

Disclaimers.

After argument of this case before the Circuit Court of Appeals for the Seventh Circuit, certain questions relating to delay in filing disclaimers were certified to this Court. Those questions were not specifically answered because sufficient facts were not before the Court. Any question regarding disclaimers was answered in a large measure, however, in the companion case of *Triplett* v. *Lowell*, 297 U. S. 638; 56 S. Ct. 645. Certain rules are to be deduced from the Court's discussion, as follows:

1. Where certain claims of a patent are held invalid, the patentee may sue again upon those claims plus others in the patent without filing disclaimers.

2. If part of the claims of a patent are found to be valid and part invalid in the first suit, the patentee must disclaim before proceeding further in the suit on the valid claims.

3. If, in a second suit, the claims previously held invalid are found to be valid the question of disclaimers does not arise as there is nothing to disclaim.

4. If, in a second suit, the claims previously held invalid are again found to be invalid the court *may* "be called upon to apply the disclaimer statute and to decide whether the patentee, under all the circumstances presented, has unreasonably neglected or delayed to enter a disclaimer of the claim of whose invalidity he had notice in the prior suit."

The facts of the present case are within this last named rule. The District Court *after holding the claims in suit to be invalid for various reasons* (Rec. 321-325) found the entire patent invalid for failure to file disclaimers. The Court of Appeals affirmed the decree of the District Court based upon these findings. From the language of this Court in *Triplett* v. *Lowell*, 297 U. S. 638, it would appear to be discretionary with the Court, under the circumstances of the last named rule, whether it pass on disclaimers or not. When all of the claims in suit are found to be invalid it is seldom of interest to an accused party whether the remainder of the claims not sued upon be declared invalid or not.

From the very nature of the questions heretofore certified in this suit, 297 U. S. 647, 648, it is obvious that the Circuit Court of Appeals considered that an unreasonable delay had occurred between the time of its earlier decisions in the Macomb and Monarch suits and the filing of the present suit. The only doubt was

whether the pendency of other suits in other judicial circuits might excuse the failure to file disclaimers (Question No. 3).

In discussing these questions this Court (297 U. S. 638, 648) said:

> "From what we have said in our opinion in No. 388, it is manifest that the effect rightly to be given to the failure to disclaim may turn upon the disposition which the trial court makes of the claims previously held to be invalid, and that there is no occasion for the application of the disclaimer statute until the trial court has itself passed on the validity of the previously adjudicated claims."

The trial court in this case passed upon the validity of the previously adjudicated claims (Rec. 324, 325) and found them to be invalid because their subject-matter involved mere mechanical skill, because of aggregation, lack of invention and prior invention. It then considered disclaimers and found all the claims to be void for unreasonable neglect and delay in filing disclaimers. The law as defined in the case of *Triplett* v. *Lowell*, 297 U. S. 638, was anticipated by the trial court.

The Disclaimer Statutes, Section 4917, R. S.; 35 U. S. C. A. 65, and Section 4922, R. S.; 35 U. S. C. A. 71, will be found as Appendix F, page xxvii at the end of this brief.

Specific Disclaimers to Some of the Claims of the Patent Do Not Affect Claims Remaining in the Patent.

Petitioner argues that all of the material and substantial parts of the patented device were in the claims previously adjudicated invalid, and that nothing remains in its patent if it disclaims these claims. The other claims are for "minutia," says petitioner. It might possibly be that the patentee, if he invented anything, invented only minutia. Claims broader than the minutia might be invalid for many reasons, including lack of invention by reason of his claiming more than he was entitled to and thereby claiming as well the prior art which he did not invent.

If a patentee disclaims his broad claim does he thereby disclaim everything in his narrow claim or claims for minutia except his particular paper lining or closure cap, etc., as petitioner contends? Petitioner thinks so because the other elements, as words, were mentioned in the broad claim. By this reasoning the entity of the claim for minutia has disappeared.

Obviously the answer is that a disclaimer to a claim disclaims the particular combination of that claim. Another claim with other coacting elements included therein is a separate and distinct combination and another entity. In *United States Metallic Packing Co.* v. *Hewitt Co.*, 236 Fed. 739, 742 (C. C. A. 7), the Court said:

> "Clearly the second claim was disclaimed because it covered, not a ring, but an old combination of the ring and the other elements used in the stuffing box. The packing ring in this combination was described only as composed of interlocking segments and formed with a conical end.

Obviously neither this claim nor its disclaimer can extend or limit the scope of the first claim, the only claim for a special ring construction."

In *Graham* v. *Earl*, 92 Fed. 155, 158, 159 (C. C. A. 9), the Court said:

"Claims 1 and 2 of the patent just referred to are exceedingly broad, and cover all possible means for holding the lids of the ventilators open in oppositely inclined positions, while its claims 3 and 4 are more narrow, and cover only the specific means therein particularly described for holding such lids open. The whole argument of the plaintiff in error upon this point seems to rest upon the proposition that, as claims 1 and 2 are broad enough in their descriptive language to include the specific combinations covered by claims 3 and 4, plaintiff's disclaimer of claims 1 and 2 was, in legal effect, a disclaimer of the particular device described in claims 3 and 4; in other words, that the particular means for holding the lids of the ventilators open as described in claims 3 and 4 were thus disclaimed, because such means are covered by the broad language of claims 1 and 2.

. . . . . .

"Applying this rule of interpretation to the disclaimer filed by the plaintiff in this action, it would seem too clear to admit of any doubt that such disclaimer cannot be given the broad and sweeping effect claimed for it by the plaintiff in error. On the contrary, the only reasonable construction which can be given the disclaimer of claims 1 and 2 is that the plaintiff intended to thereby limit his patent to the specific invention described in the remaining claims of his specifications, and not to abandon such remaining claims."

In Section 650 (Volume II, p. 289) of Robinson on Patents appears the following:

"The effect of a disclaimer is confined to the excess which it removes from the apparent pro-

> tection of the patent. Except as to this the patent remains operative to the same extent as before the disclaimer was filed. The disclaimer of a void Claim does not affect such other Claims of the patent as by themselves are valid, nor does the disclaimer of the excessive portion of a Claim impair the force of what is not disclaimed."

This observation shows that Robinson realized the distinction made between disclaiming excess parts of a claim and disclaiming a whole claim of excess where other claims remain in the patent. It effectively disposes of petitioner's argument that there is no such distinction, and that, with the invalidation of certain claims, if disclaimers were filed, nothing would remain in the patent as expressed by the other claims.

The case of *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon, Inc.*, 294 U. S. 477, 489, 490; 55 S. Ct. 455, 460, cited by petitioner, deals with circumstances where the patentee attempts to amend a claim by disclaiming a part of that claim or amends by adding elements to that claim by disclaimer, and has no bearing upon this case. Of course, when a patentee has disclaimed a claim as a whole, anyone may make, use or sell the entity defined in that claim as stated by this Court in the Altoona case.

Petitioner is not asked to give up one element of an entity but to give up an entire entity that does not belong to it in order to hold on to another entity that may belong to it.

Conclusion.

The basis for the grant of the writ in this case is the alleged conflict of decisions between the Circuit Courts of Appeals for the Sixth and Seventh Circuits brought about by the testimony of the witnesses Brainard and Terry. The conduct of the case through the District Court and Court of Appeals of the Sixth Circuit has been shown to have been substantially an *ex parte* proceeding and based on an *ex parte* record. The Sixth Circuit accepted the testimony of Brainard and Terry as indicative of invention by Blair, but only on a strained interpretation of the evidence, and as equally a strained construction of claim 1 into which the Circuit Court of Appeals was compelled to read unwarrantedly limitations of structure not even found in the text of the Blair patent. That Court did not have before it the same record of the testimony of Brainard and Terry as was before the Court of Appeals for the Seventh Circuit. There was no cross-examination of these witnesses before the Sixth Circuit as was before the Seventh Circuit. Conclusions were reached by the Sixth Circuit which doubtless would not have been reached had the record of the Seventh Circuit been before the Sixth Circuit.

It is clear, therefore, that this Court is called upon to review this case as to facts adduced in the testimony of Brainard and Terry—not as to principles of law concerning which a conflict has arisen that affects the public generally.

It is a determination merely of questions purely personal to the parties involved and not of public import.

In the circumstances outlined it is believed that the

writ of certiorari herein was improvidently granted and the same should be dismissed.

Aside from the foregoing considerations which impel dismissal of the writ, the Blair patent in suit has been shown to be destitute of validity because of lack of invention, want of sufficient disclosure of the subject-matter and prior invention.

Respondent's jug also does not infringe.

The Circuit Court of Appeals of the Seventh Circuit having had before it the cross-examination of the witnesses Brainard and Terry, and being possessed of a record more complete than the record before the Sixth Circuit Court of Appeals, there can be little question as to the correctness of the findings of invalidity of the Blair patent by the Seventh Circuit, and these findings should be upheld.

Respectfully submitted,
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